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10/601,574	06/24/2003	John J. O'Mahony	3659-67	8253
23117	7590	06/09/2006	EXAMINER	
NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203				DEAK, LESLIE R
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/601,574  
Filing Date: June 24, 2003  
Appellant(s): O'MAHONY ET AL.

**MAILED**  
**JUN 09 2006**  
**Group 3700**

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Jeffry Nelson  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 7 April 2006 appealing from the Office action mailed 25 August 2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The amendment after final rejection filed on 7 April 2006 has been entered and claims 59 and 60 have been cancelled.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**WITHDRAWN REJECTIONS**

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner.

Examiner withdraws the 35 USC 103 rejection of claims 82-85, but upholds the underlying 35 USC 102 rejection.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

5,690,931                    KENLEY et al                    11-1997

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 82-85 are rejected under 35 U.S.C. 102(b) as anticipated by US 5,690,831 to Kenley et al.

In the specification and figures, Kenley discloses the device as claimed by applicant.

In particular, Kenley discloses an extracorporeal treatment circuit 28 with draw line 432 and return line 470. Return line 470 is fluidly connected to patient venous line 492, meeting applicant's limitation drawn to a return line "connectable," that is, able to be connected, to a patient access. In this case, return line is connectable to and is, in fact connected to patient access line 492.

The circuit comprises a reversible blood pump 458 and associated actuator that interacts with the fluid line at 462 (see FIG 13). The circuit further comprises a filter 404 connected to the draw and return lines, and blood sensors 446 and 486 that act as blood leak detectors (see FIG 13, column 33, lines 39-50).

The pump disclosed by Kenley is operable in a forward direction in which positive pressure is generated to the fluid return line 470 in order to return blood to the patient. The pump is further disclosed as being operable in a reverse mode, which necessarily creates a negative pressure in the fluid return line 470 (see column 50, lines 7-14). Kenley discloses that the operation of the pump in reverse will draw fluid out of chamber 472, lowering the level of blood until air is sensed by sensor 476 (see column 26, lines 50-64). In order to draw fluid out of the chamber when the pump operates in reverse, the return line must exhibit a negative or reverse flow.

Applicant merely sets forth that the claimed device has “a first configuration” in which the pump generates a positive pressure and a “second configuration” in which the pump generates a negative pressure, reversing the flow in the return line. Such a recitation sets forth the intended use of the device. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. See MPEP 2114. In the instant case, the Kenley device sets forth the structural limitations claimed by applicant and further discloses a pump that is capable of performing the function claimed by applicant. Applicant’s claimed function does not set forth any structural limitations of the claimed device and fails to differentiate the claimed apparatus from the prior art. The Kenley disclosure meets the limitations of applicant’s claims.

#### **(10) Response to Argument**

Applicant argues that the Kenley device does not anticipate the claimed invention since Kenley does not disclose a pump actuator having a second configuration in which a negative pressure is generated in the return line. However, Kenley clearly discloses in column 26, lines 50-64, that the blood pump may be operated in reverse, generating a negative pressure in return line 470. Applicant argues that there is no pump in the blood line between chamber 472 and the patient. However, applicant’s argument is narrower than the presented claims. Applicant does not claim that the pump must be disposed between a drip chamber and the patient.

Applicant appears to be arguing that the claimed return line should equate to Kenley's venous line 492. Even so, Applicant merely claims an extracorporeal circuit with a pump that has a configuration in which it is *possible* to create a negative pressure in the return line. The examiner notes that when the Kenley pump operates in reverse, it is possible to create a vacuum in the chamber 472 that would draw fluid from Kenley's venous line 492. Applicant's claim merely requires that the prior art is capable of performing the claimed function. The Kenley device is capable of producing a negative pressure and reverse flow in either fluid line 470 or 492.

Applicant further argues that the pump disclosed by Kenley is not configured to reverse a flow in both the draw line and the return line. However, the Kenley pump is located in the draw line, and is disclosed as generating a negative pressure in the return line. If the Kenley pump is operated in reverse, it must reverse flow in at least a portion of the draw line between the pump 458 and clamp 444.

Applicant further argues that Kenley does not disclose a reverse flow operational mode in which the actuator generates a negative pressure in a fluid line and flow through the line is reversed. However, Kenley clearly discloses in column 26, lines 50-64, that the blood pump may be operated in reverse, generating a negative pressure in return line 470. The negative pressure causes a reversal of flow in line 470 as fluid is drawn out of chamber 472.

Finally, applicant notes that the pending claims were substantively copied from claims 54 and 55 of US 6,572,576 to Brugger et al in order to provoke an interference. Applicant argues that the Examiner should allow the pending claims for the same

reasons that the PTO allowed claims 54 and 55 of the '576 patent. Examiner notes that the '576 patent was not handled by the Examiner in the pending case. However, MPEP § 2307.2 indicates that the Examiner should determine whether the presented claims are unpatentable on any ground(s), including 35 USC 102 and 35 USC 103. Since the examiner has found such grounds for rejection, it is made herein.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Leslie Deak  
Examiner, Art Unit 3761

Conferees:

  
Angela Sykes  
Supervisory Patent Examiner, Tech Center 3700

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